



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,009	08/25/2003	Amlan Datta	129843.1104	3329

60148 7590 06/14/2006
GARDERE / JAMES HARDIE
GARDERE WYNNE SEWELL, LLP
1601 ELM STREET
SUITE 3000
DALLAS, TX 75201

EXAMINER

MARCANTONI, PAUL D

ART UNIT	PAPER NUMBER
----------	--------------

1755

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/648,009

Applicant(s)

DATTA ET AL.

Examiner

Paul Marcantoni

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's arguments filed 5/17/06 have been fully considered but they are not persuasive. The applicants' amendment necessitated the new grounds of rejection below:

New Matter:

Claims 1-3 and 5-15 are rejected under the first paragraph of 35 USC 112 and 35 USC 132 as the specification as originally filed does not provide support for the invention as is now claimed.

The terms "between about" before the range of 4 to 10 wt% sodium oxide is new matter. There is only support for *about* from paragraph [0027] from applicants' specification. This is not a suggestion but only a commentary on the state of new matter as a result of applicants' amendment. Note that the remaining new limitations to claim 1 and other claims are supported by the original disclosure.

35 USC 112 Second Paragraph:

Claims 1-3 and 5-15 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The terms "between about" are indefinite together. The use of one or another is not indefinite but both together ~~does not~~ seem to make the endpoints vague. The applicant's amendment necessitated this rejection.

Obviousness Type Double Patenting:

Claims 1-3 and 5-15 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over all claims of Datta et al. (2004/0081827 A1 which is 10/648,184) and Datta et al. (2004/0080063 A1 which is 10/648,585). Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach a composition that can be used for a building material containing hollow inorganic microspheres.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The applicants have again said that they will hold in abeyance the sending of a terminal disclaimer until indication of allowable claims. This is not the proper procedure for overcoming the ODP rejection. Applicants were required to submit a timely terminal disclaimer. They did not do so. It would have been timely to submit the terminal disclaimer in response to the examiner's first office action. As a result of the failure to submit a timely terminal disclaimer, an after final submission of a terminal disclaimer could be thus considered untimely.

35 USC 102/103

Claims 1-3 and 5-15 are rejected under 35 U.S.C. 102(a and b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious or Pawlowski et al. (see abstract).

Note: The references no longer in this rejection were withdrawn because they do not teach the range of amounts of components that comprise the synthetic microsphere. Also, Yamada et al. '886 A1 does teach the specific synthetic microsphere but did not teach the microsphere diameter of 30 to 1000 microns. The highest particle diameter was 20 microns (see [0023]) and the reference teaches away from using larger than 20 microns particle diameter (see [0023]).

Pawlowski et al. teach a hollow microsphere derived from coal ash with a composition that is in applicants' claimed range for synthetic microsphere (see abstract and page 7 of applicant's specification).

Response:

The examiner is in agreement on the commentary on why the other references should be withdrawn and they were withdrawn as shown above. However, the examiner disagrees regarding Pawlowski et al. The applicants argue that Pawlowski does not teach a range of "about" 5.2 to 30 wt% CaO. In rebuttal, the term "about" permits some tolerance. At least about 10% was held to be anticipated by a teaching of a content not to exceed about 8%. In re Ayers, 154 F 2d 182, 69 USPQ 109 (CCPA 1946). A pressure limitation of 2-15 PSI was held to be readable on a reference which taught a pressure "of the order of about 15 PSI." In re Erickson, 343 F 2d 778, 145 USPQ 207 (CCPA 1965). It is the examiner's position that "about" 5.2 wt% CaO could potentially be inclusive of the amount of "4.5 wt% CaO". It is further noted that the other

Art Unit: 1755

amounts or ranges of amounts do overlap the applicants' claimed synthetic microsphere.

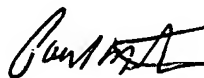
It is the examiner's position that he fully responded to the applicants' comments/arguments and the finality of this office action is now proper.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
Art Unit 1755